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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,957	04/19/2000	Eric C. Perlin	MSI-385US	3826

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EXAMINER

KENDALL, CHUCK O

ART UNIT PAPER NUMBER

2122

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/551,957

Applicant(s)

PERLIN ET AL.

Examiner

Chuck Kendall

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-49 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 41-43, 45-47 and 49 is/are rejected.
7) ☒ Claim(s) 44 and 48 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.11.12.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the application filed 03/05/2004.
2. Claims 41 - 49 have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 41 & 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett USPN 6,173,419 in view of Arlington et al. USPN 4,888,773.

Regarding claim 41, Barnett discloses, an application development system comprising: a computer system to execute an application within an application development tool (2:1-10), coupled to the computer system, to receive and identify debug frames interlaced with application frames within a normal communication flow between the application executing on the computer system and the smart card, wherein the smart card development interface promotes the application frames to an application layer of the smart card, and invokes debug features of the smart card in response to debug instructions embedded within the received debug frames (Col. 5 lines 30 to 60).

Although Barnett doesn't explicitly disclose a smart card incorporating a smart card development interface, Barnett describe a smart card can be used along with the emulator. However, Arlington does disclose a smart card architecture including an interface to be used with a broad range of hardware technologies and in different systems (e.g. see abstract, col. 4: 27-34, FIGs 3-7 and associated text). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was

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made to combine Barnett and Arlington because, smart cards can be used with a broad range of systems and hardware hence making it very flexible and compatible.

Regarding claim 42, an application development system according to claim 41, wherein the computer system further comprises:

a client development interface (fig 7, item # 118), to interlace debug frames generated by the application development tool with application frames generated by the application executing within the application development tool. Although Barnett doesn't explicitly disclose a smart card incorporating a smart card development interface, Barnett describe a smart card can be used along with the emulator. However, as noted above Arlington does disclose a smart card architecture including an interface to be used with a broad range of hardware technologies and in different systems (e.g. see abstract, col. 4: 27-34, FIGs 3-7 and associated text). Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Barnett and Arlington because, smart cards can be used with a broad range of systems and hardware hence making it very flexible and compatible.

5. Claims 43 - 49 are rejected under 35 U.S.G. 103(a) as being unpatentable Barnett USPN 6,173,419 in view of Arlington et al. USPN 4,888,773 and further in view of Jacobson USPN 3,195,774.

Regarding claim 43, Barnett as modified by Arlington discloses all the claimed limitations as applied in claim 42 above. The combination of Barnett and Arlington, doesn't expressly disclose wherein the application development tool generates debug frames in response to user interaction with the application development tool. However, Jacobson doesn't show this functionality in a similar environment (Jacobson, Col. 21, lines 37 to line 40). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Barnett and Arlington with Jacobson because, using interfaces to interact with users makes the system more automated and thus more efficient. Regarding claim 45, an application development system according to claim 43, wherein the debug frames invoke and control one or more smart card

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resources facilitating debugging of the application executing within the application development tool of the computer system (5:35-50).

6. Claims 43 - 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett USPN 6,173,419 in view of Arlington et al. USPN 4,888,773 as applied in claims 41 and 42, in view of You et al. USPN 5,787,245 (hereinafter You).

Regarding claim 46 & 47, Barnett as modified by Arlington discloses all the claimed limitations as applied in claim 42 above. The combination of Barnett and Arlington doesn't explicitly disclose, wherein the client development interface includes a debug filter to identify and route debug frames received from the smart card. However, You does disclose this feature ('4:35-39). Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine Barnett and Arlington with You because, using filters to identify and route debug data ensures that the data reaches it's respective locations, hence making the system more dynamic.

Regarding claim 49, an application development system according to claim 41, further comprising:

- a communication protocol, employed by the computer system and the smart card to communicate there between, the communication protocol comprising;

- a plurality of application frames comprising a normal communication flow between a host application and a smart card application (Barnett, fig 2); and

- one or more debug frames, interlaced with the application frames within the normal communication flow, to enable a debug application executing on the host system to selectively access and control smart card resources (Barnett, fig 6, 108,104).

Response to Arguments

7. Applicant's arguments with respect to claims 41 – 49 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

8. Claims 44 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art doesn't teach or render obvious to the following:

"... wherein the application development tool populates a source and/or destination field of the debug frame with an invalid source and/or destination address".

Correspondence Information

9. Any inquires concerning this communication or earlier communications from the examiner should be directed to Chuck O. Kendall who may be reached via telephone at (703) 308-6608. The examiner can normally be reached Monday through Friday between 8:00 A.M. and 5:00 P.M. est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900. For facsimile (fax) send to central FAX number 703-872-9306 and 7037467240 draft.

Chuck Kendall

Patent Examiner AU, 2122.



TUAN DAM
SUPERVISORY PATENT EXAMINER